

REMARKS

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Rejection Under 35 U.S.C. § 103(a)

At Section 6, page 3 of the Action, claim 1-76 have been rejected under 35 U.S.C. §103(a) as allegedly being anticipated by Albazz *et al* in U.S. Patent Application Publication No. 2002/0042782.

At Section 8, Examiner concludes that "although Albazz does not use the specific terms and steps of the instant application, it would be obvious to one of ordinary skill in the art to modify Albazz in order to obtain the instant application. For example, including the various types of contract, such as leases or technology licenses, or including the fields herein disclosed." Applicants respectfully disagree.

First, Applicants' invention "may be used for any type of contract document" (page 6, lines 6-7) including "patent licenses, trademark licenses, copyright licenses, technology licenses, joint ventures, confidentiality agreements, research agreements, technical assistance agreements, technology or software evaluation agreements, engineering services agreements, technology testing agreements, manufacturing agreements, technology/product leasing agreements, technology/product sales agreements, technology process design agreements, consulting agreements, etc." (page 6, lines 10-16) Albazz does not teach, show or suggest a contract management system for use with any type of contract, but rather teaches a "system for generating a contract between a seller and a buyer". See page 2 at paragraph 15. The Albazz system cannot be used to generate a contract unless the desired terms and conditions are contained in the Business Rules Book. Applicants' system, on the other hand, is not limited to a specific set of terms and conditions. Rather, as indicated in independent claims 12, 29, 43, 54, 62, 69 and 76, Applicants' inventive system includes the step of "drafting a contract or receiving a draft contract, ..." which may include any terms and conditions whatsoever.

Next, the specific terms and steps in Applicants' application are not merely names or labels applied to fields. Rather the fields of the current invention are unique and are specifically indicative of the use and functionality of the invention, as described throughout the specification and in these Remarks below. "Functional descriptive material is a limitation in the claim and must be considered and addressed in assessing patentability under 35 U.S.C. 103. Thus, a

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rejection of the claim as a whole under 35 U.S.C. 103 is inappropriate unless the functional descriptive materials would have been suggested by the prior art." [See MPEP 2106, Section VI, citing *In re Dembiczak*, 175 F.3d 994, 100, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999)].

Applicants claim a "system capable of generating reports" wherein the reports are "obtainable through search of said fields", see independent claims 1, 12, 29, 43, 54, 62, 69 and 76. These are specific functional descriptive limitations that Examiner has failed to show in the prior art. These limitations are fully supported by Applicants' specification which provides in part "[t]he fields of the database are used to generate reports that are in turn used to track, manage and administer various contract obligations" (page 8, lines 19-20) and "they can be used for business forecasting and planning" (page 8, line 21). The disclosure in Albazz does not suggest any report generating capability, the use of reports to track, manage and administer contractual obligations nor the use of reports for business forecasting and planning, either from field data or otherwise.

Other specific examples of functional descriptive material in the present application as it relates to report generation functionality based upon the uniquely defined fields of Applicants' invention which are not taught, shown or suggested by Albazz include "retrieving from said database a report of outstanding obligations" and further analyzing the report, making decisions based upon the report, taking action based on the analysis of the report and updating the database based on the action taken, as recited in claims 12-16.

Next, Albazz does not teach, show, or suggest "retrieving from said database a report of outstanding financial obligations" and further analyzing the report, making decision based upon the report, making or receiving a payment based upon the analysis of the report and updating the database to reflect payment or receipt of payment, as recited in claims 29-33. Conversely, contracts according to Albazz, "are exposed to other e-commerce subsystems, such as order management, fulfillment, billing and payment, services, etc." (paragraph 0098) thereby teaching away from Applicant's invention.

Further, Albazz does not teach, show, or suggest "obtaining from said database an invoice or payment letter wherein said invoice or payment letter is generated automatically using said stored data; and sending the invoice or payment letter", as recited in claim 54 and those dependent therefrom. Again, see Albazz at paragraph 0098.

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Still further, Albazz does not teach, show, or suggest "generating from said database a list of payments due; obtaining from said database an invoice or payment letter wherein said invoice or payment letter is generated automatically using the data stored in said database; sending the invoice or payment letter; and updating the database to reflect that payment was made or to reflect receipt of payment", as recited in claim 62 and those dependent therefrom.

Further yet, Albazz does not teach, show, or suggest "obtaining from the database an indication as to whether the draft is being reviewed and/or executed; storing, after execution of said draft, data obtained from the resulting contract in said database, said data comprising payment triggering event data; and generating from said database a report of payment triggering events", as recited in claim 69 and those dependent therefrom.

If Examiner contends that any of the specific functional descriptive limitations contained in Applicants' claims, as described above, are in fact disclosed or suggested by the prior art, specific column and line citations would be appreciated.

Applicants further traverse this rejection on grounds that the Examiner has not established a *prima facie* case of obviousness. To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. See In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Further, the teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not in the applicants' disclosure. See M.P.E.P. § 2143, citing In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

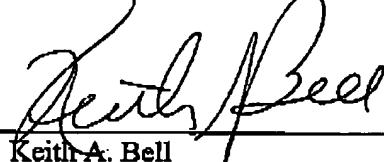
As mentioned above, the purpose of Albazz's system is to facilitate contract negotiation and contract preparation using a set of predetermined terms and conditions between a buyer and seller. Applicants contend that it would not have been obvious for a person of ordinary skill in the art to look to Albazz for guidance on creating a contract generation and administration system for use with any type of contract document, said system including report generation, report analysis and decision-making capabilities, invoice generation and payment tracking capabilities. Again, if Examiner disagrees with this statement, specific column and line citations would be appreciated.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be

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best resolved through a telephone interview, she is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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Date

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